

### Remarks

In response to the restriction requirement of March 23, 2007, applicants elect provisionally, with traverse, the invention of:

#### **Group II, claims 12 to 16 and 20 to 22.**

Within this group II, applicants elect provisionally, with traverse, SEQ ID. No. 8.

Applicants would like to traverse the restriction requirement for the following reasons:

37 CFR § 1.475 defines "special technical features" as those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

The Office identified the "DR-4 nuclear receptor binding site" as the technical feature shared by identified Group I and II, but expressed the opinion that this technical feature lacks novelty or inventive step in view of Kaul et al (AC097637.2; sequences 153093- 153266; attached).

Applicants respectfully submit that, in identifying the special technical feature, the recited activity of the claimed nucleic acid should be included, namely its activity as a transcriptional enhancer of the 5-aminolevulinic acid synthase gene.

In order to clarify the identity of the special technical feature under 37 CFR §1.475, applicants have added the activity of the claimed nucleic acids sequences explicitly to all claims.

In 1996 the Commissioner has decided *sua sponte* to partially waive 37 CFR 1.475 and 1.499 et seq. to permit applicants to claim up to ten (10) nucleotide sequences which do not have the same or corresponding special technical feature. Per OG Notice of March 27, 2007 the Office officially rescinded this partial waiver. The Notice noted that for national stage filings of international applications under 35 U.S.C. 371, unity of invention determination will be made in view of PCT Rule 13.2, 37 CFR 1.475 and Chapter 10 of the ISPE Guidelines. In particular, the Notice states that Unity of Invention will exist when the polynucleotide molecules, as claimed, **share a general inventive concept**, i.e., share a technical feature which makes a contribution over the prior art.

Thus, the argumentation provided herein applies to both, the restriction between Group I and Group II and the restriction between the different nucleic acid sequences.

In this context, the Office is directed to Example 4, 33 and 36 of chapter 10 of the **PCT INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION GUIDELINES** (the guidelines).

Example 4 of the guidelines, is one of the general examples that demonstrate that, e.g., a particular activity or use of a compound, can constitute a special technical feature:

*Example 4*

*Claim 1: Use of a family of compounds X as insecticides.*

*Claim 2: Compound X1 belonging to family X.*

The guidelines state in context of this example that provided X1 has the insecticidal activity and the special technical feature in claim 1 is the insecticidal use, unity is present.

Applicants attaches hereto examples relevant for biotechnology inventions. Applicants would in particular direct the Office's attention to examples 33 and 36. The

examples make clear that the DR-4 nuclear receptor binding site should be viewed in conjunction with the recited common activity of the sequences comprising these structural elements, namely the “transcriptional enhancer of the 5-aminolevulinic acid synthase gene” activity when identifying the special technical feature (A DR-4 nuclear receptor binding site is defined in the paragraph bridging pages 9 and 10 of the specification).

Irrespective of what has been said above, applicants would like to point out that many of the specified sequences are related:

On page 25, in the paragraphs starting on line 13 and 30, the specification makes clear that SEQ ID Nos. 3, 4, 5, 6 and 7 originate from the same 2.6 kb fragment and show significant overlap (see, in particular, SEQ ID Nos. 4 and 5 and SEQ ID Nos. 6 and 7).

On page 31, in the paragraph starting on line 19, the specification makes clear that SEQ ID 8 results from dissecting SEQ ID No. 9.

On page 34, in the paragraph starting on line 3, the specification makes clear that SEQ ID 39 constitutes a fragment of SEQ ID No. 10.

Thus, a separate search and examination of these sequences would appear to result in a duplication of efforts.

**New claim 23** is supported by the description as a whole, for example, on page 10, in the paragraph starting on line 19.

The fee for a one month extension of time and one claim in excess of 20 is submitted herewith. No additional fees are believed to be due with this response, however the Commissioner is authorized to charge deposit account 50-3135 for fee's that might be required for consideration of this paper.

Respectfully submitted,

By /Joyce v. Natzmer/  
Joyce von Natzmer  
Registration No. 48,120  
**Customer No. 46002**  
Telephone: (301) 657-1282

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